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108,036

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
108,036	05/17/93	BONATI	831.10(3)

FSM1/0526

BENNETT, C.	EXAMINER
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ART UNIT	PAPER NUMBER
3307	2

DATE MAILED: 05/26/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☐ Responsive to communication filed on \_\_\_\_\_. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 1 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.       |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-15 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims \_\_\_\_\_ are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☒ Claims 1-15 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

**EXAMINER'S ACTION**

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***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claim 1, drawn to a push knob for a guide wire, classified in Class 606, subclass 1.

Group II. Claims 2-6, drawn to a dilator tube, and the associated method of using said dilator tube, classified in Class 606, subclass 191.

Group III. Claim 7, drawn to a ligament cutter, classified in Class 606, subclass 170.

Group IV. Claim 8, drawn to a cervical osteotome, classified in Class 606, subclass 84.

Group V. Claims 9 and 11, drawn to a cervical curette, classified in Class 606, subclass 160.

Group VI. Claim 10, drawn to a sheer-type nucleus extractor, classified in Class 606, subclass 174.

Group VII. Claims 12-14, drawn to a method of for debulking a cervical tissue, classified in Class 128, subclass 898.

Group VIII. Claim 15, drawn to a method of removing a protruding tissue from abutting engagement with a nerve, classified in Class 128, subclass 898.

The inventions I-VI are distinct, each from the other because of the following reasons:

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2. Inventions are disclosed as different combinations which are not connected in design, operation or effect. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01).

In the instant case, the inventions of Groups I-VI have different functions. The push knob is used for aiding in inserting a guide wire; the dilator tube is used to dilate an incision; the ligament cutter is used to cut ligaments; the cervical osteotome is used to cut bone; the cervical curet is used to remove tissue; and the nucleus extractor is used to extract a nucleus.

Inventions II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the process can be practiced using a dilator tube having a base without a recess and not having a water port.

Inventions II and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product

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(M.P.E.P. § 806.05(h)). In the instant case the dilator tube can be used for removing bone chips from an elbow of a patient.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Chris A. Bennett at telephone number (703) 308-0980.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

  
C. A. Bennett  
Patent Examiner  
Art Unit 3307

CAB   
May 25, 1994